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|---|-------------|----------------------|--------------------------------|------------------|
| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.            | CONFIRMATION NO. |
| 10/527,799  | 08/17/2005  | Paul Beswick         | PG4893USW                      | 7090             |
| 23347   | 7590        | 01/11/2008           |                                |                  |
| GLAXOSMITHKLINE<br>CORPORATE INTELLECTUAL PROPERTY, MAI B475<br>FIVE MOORE DR., PO BOX 13398<br>RESEARCH TRIANGLE PARK, NC 27709-3398 |             |                      | EXAMINER<br>MORRIS, PATRICIA L |                  |
|   |             |                      | ART UNIT                       | PAPER NUMBER     |
|   |             |                      | 1625                           |                  |
|   |             |                      | NOTIFICATION DATE              | DELIVERY MODE    |
|   |             |                      | 01/11/2008                     | ELECTRONIC       |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USCIPRTP@GSK.COM  
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|                              |                                       |                                       |  |
|------------------------------|---------------------------------------|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/527,799  | <b>Applicant(s)</b><br>BESWICK ET AL. |  |
|                              | <b>Examiner</b><br>Patricia L. Morris | <b>Art Unit</b><br>1625               |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4,6-8,11,14,17-19 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) 7,11,19,21-23,25 and 26 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4,6,8,24 and 27 is/are allowed.
- 6) ☒ Claim(s) 14,17 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

Claims 1-4, 6, 8, 14, 17, 18, 24 and 27 are under consideration in this application.

Claims 7, 11, 19, 21-23, 25 and 26 remain held withdrawn as being drawn to nonelected subject matter 37 CFR 1.142(b).

#### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 11, 2007 has been entered.

#### *Election/Restrictions*

The requirement is still deemed sound and proper and is therefore maintained.

Again, this application has been examined in regard to the elected compounds wherein X is oxygen or  $\text{NR}^2$ , Y is CH,  $\text{R}^1$ ,  $\text{R}^2$  and B represent non-heterocyclic containing groups, A is (optionally substituted) aryl and  $\text{R}^3$ ,  $\text{R}^6 - \text{R}^{10}$  and n as set forth in claim 1 exclusively. Claim 25 has been examined to the extent readable on the elected method, *i.e.*, rheumatoid arthritis and osteoarthritis.

Applicants continue to fail to present an independent claim to the **elected method, *i.e.*, rheumatoid arthritis and osteoarthritis mediated by COX-2**. Applicants have now broadened the scope of the elected method of use. Hence, the nonelected method and process claims will not be rejoined at this time because applicants have failed to present the **elected method of use in independent form**.

The method claims will not be rejoined at this time because applicants have **failed to limit the claims to the elected products**. Further, applicants are reminded that any rejoined method claims, to be **allowable**, the rejoined claims **must meet all criteria for patentability** including the requirements of 35 U.S.C. 101, 102, 103 and 112. As clearly set forth in the record, the withdrawn claims do **not meet the criteria**. In the instant case, none of the withdrawn claims meet all the criteria for patentability and are not allowable. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is *presented prior to* final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 17 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

No support can found for the treatment of rheumatoid arthritis or osteoarthritis. There are many biochemical pathways that mediate rheumatoid arthritis or osteoarthritis. Mediators include bradykinin, serotonin, histamine, assorted cytokines etc.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14, 17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 14, 17 and 18 continue to depend on a withdrawn claim. Further, claims 17 and 18 lack antecedent basis because withdrawn claim 11 does not recite the **elected method, i.e., *rheumatoid arthritis and osteoarthritis mediated by COX-2.***

***Allowable Subject Matter***

Claims 1-4, 6, 8, 24 and 27 are allowed

***Conclusion***

Claims 14, 17 and 18 are not allowed.

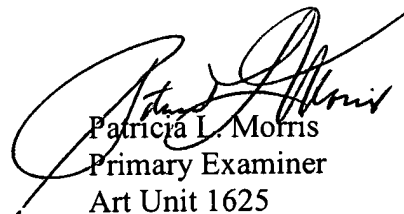
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Morris whose telephone number is (571) 272-0688. The examiner can normally be reached on Mondays through Fridays.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:  
10/527,799  
Art Unit: 1625

Page 5

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Patricia L. Morris  
Primary Examiner  
Art Unit 1625

plm  
January 3, 2008